

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBORU AIBA, FUMIAKI MOCHIZUKI,
and RYUICHI SAGUCHI

Appeal No. 2005-2649

Application No. 09/690,377

HEARD: December 13, 2005



Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 6 and 9, all of the claims remaining in the application. Claims 1 through 5, 7 and 8 have been canceled.

Appellants' invention is directed to a method for preparing an annular sustained release pheromone-dispenser. Independent claim 9 is representative of the subject matter on appeal and a

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copy of that claim can be found in the Appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Coplan et al. (Coplan) 4,017,030 Apr. 12, 1977

Sakurada et al. (Sakurada) 5,993,843 Nov. 30, 1999

Claims 6 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Coplan in view of Sakurada.

Rather than attempt to reiterate the examiner's commentary with regard to the above-noted § 103 rejection and the conflicting viewpoints advanced by appellants and the examiner regarding that rejection, we make reference to the examiner's answer (mailed March 31, 2005) for the reasoning in support of the rejection, and to appellants' re-submitted brief (filed January 25, 2005) and reply brief (filed June 2, 2005) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination that the above-noted § 103 rejection will not be sustained. Our reasons follow.

In rejecting method claims 6 and 9 under 35 U.S.C. § 103(a), the examiner contends that Coplan discloses

a method for preparing an annular sustained release pheromone-dispenser whose end portions are connected to each other (Figs. 3a and 3b); comprising the steps of arranging a plurality of continuous plastic tubes (Figs. 3a and 3b) wherein the tubes have a diffusivity and a permeability to a liquid synthetic (Abstract lines 1-3) which are filled with a liquid synthetic sex pheromone (Fig. 1); fusing them at a predetermined pitches by heating under a pressure and then cutting then at each fused portion to produce a dispenser composed of two side by side tubes having closely sealed both end portions (Figs. 3a and 3b; column 8, lines 53-57) (answer, page 4).

The examiner concedes that Coplan does not disclose 1) cutting the tubes at a middle of each fused portion or 2) pulling apart the center portion of the dispenser to separate the central portion of each tube from the central portion of the other tube

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as set forth in claim 9 on appeal. To account for the first of these differences the examiner contends that

it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Coplan's method by cutting the tubes at a middle of each such fused portion, since applicant has not disclosed that cutting the tubes at a middle of each such fused portion solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with Coplan cutting line by the end of the fusing portion (Fig. 3a) Note that Coplan at Fig. 4a inherently disclosing cutting the tube at a middle of the fused portion (Fig. 4a and column 7, lines 30-36) to come up with the tube shown at Fig. 4b. (answer, page 5).

Concerning the second difference, the examiner turns to Sakurada, urging that this patent discloses a method for preparing an annular sustained release pheromone-dispenser comprising the step of pulling apart a central portion of the dispenser to separate the central portion of each tube from the central portion of the other tube (Fig. 1 at 18; col. 14, line 65 - col. 15, line 2). Based on such teaching, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to have modified Coplan's method to include the step of pulling apart a central portion of the dispenser to separate the central portion

of each tube from the central portion of the other tube, as suggested in Sakurada.

As appellants have pointed out in the reply brief (pages 1-3), the examiner's position as set forth above totally mischaracterizes the invention disclosed by Coplan. Of particular concern is the fact that, contrary to the examiner's findings, Coplan has no disclosure whatsoever of an annular sustained release pheromone-dispenser wherein the dispenser uses continuous plastic tubes which have "a diffusivity and a permeability to a liquid synthetic sex pheromone," as required in claim 9 on appeal. To the contrary, Coplan expressly discloses that the attractant or pheromone (8) contained in the tubes (2) of the dispenser therein "does not escape from the tubes until the tubes are severed at selected spots between seal regions" (col. 9, lines 29-32) to thereby define or provide an open end that allows the pheromone to be released by evaporation from an atmospheric or air interface with the liquid exposed at or near the open end of the tube. Indeed, any escape of the pheromone from the dispenser of Coplan prior to cutting of the tubes would be antithetical to the entire teaching of this patent.

Nor do we find in Coplan any teaching or suggestion of the step of fusing the tubes at predetermined points by heating under pressure "to connect the tubes to each other and to seal each tube at the points," as set forth in claim 9 on appeal. In each instance in Coplan, the tubes are adhesively affixed to a backing member (Figs. 14-16) or embossed from a flat sheet that is then adhered to a base sheet (Figs. 12-13) to define the capillary tubes. The fusing or heat sealing that takes place in Coplan is applied to seal each tube at selected points (49 or 70) to define closed sections of tubing (e.g., 72) that will each contain an amount of pheromone sealed therein, not to connect the tubes to each other.

As for Sakurada, the examiner indicates on page 6 of the answer that this patent is utilized only to show the teaching of pulling apart a central portion of adjacent dispensing tubes. However, from our perspective, the pheromone-dispenser taught in Sakurada is much closer to the dispenser described in the present application than is that of Coplan. See the dispenser (18) in Figure 1 of Sakurada and the description of Example 13 in column 17, line 56+. However, it is clear to us that neither Coplan nor

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Sakurada disclose, teach or suggest the method as set forth in claim 9 on appeal. Moreover, we fail to find any reasonable basis in the applied patents for attempting to modify the method of Coplan, based on Sakurada, in a manner that would render the claimed method obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

In the final analysis, we agree with appellants that the examiner's attempted combination of the different forms of dispensers and methods of Coplan and Sakurada represents an improper exercise in hindsight reconstruction of the claimed method based on appellants' own teachings. For that reason, and those otherwise expressed above, we will not sustain the examiner's rejection of claim 9 under 35 U.S.C. § 103(a).

Claim 6 adds to claim 9 the requirement that the plurality of plastic tubes be fused by heating under pressure "after sandwiching the portion to be fused between a pair of pieces made of a plastic identical to that of the plastic tubes." This aspect of the method is illustrated in Figure 4 of the application. According to the examiner (answer, page 5), Coplan

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discloses such a method step in Figures 12 and 13, and at column 8, lines 53-58. Suffice to say that the examiner has again totally mischaracterized the disclosure of Coplan. Nothing in Coplan teaches or suggests a method step wherein a plurality of tubes are sandwiched between a pair of pieces made of a plastic identical to that of the plastic tubes and then fused by being heated under pressure to connect the tubes to each other and to seal each tube at predetermined points. Certainly Figures 12 and 13 of Coplan do not show or suggest such a step and the disclosure at column 8, lines 53-58 has nothing whatsoever to do with any such fusing step. Thus, the rejection of claim 6 under 35 U.S.C. § 103(a) will likewise not be sustained.

In light of the foregoing, the decision of the examiner to reject claims 6 and 9 of the present application under 35 U.S.C. § 103(a) is reversed.

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REVERSED

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

Jeffrey V. Nase

JEFFREY V. NASE
Administrative Patent Judge

Jennifer D. Bahr

JENNIFER D. BAHR
Administrative Patent Judge

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